

REMARKS

The Office Action dated December 6, 2005, has been received and carefully considered. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

I. THE NON-STATUTORY SUBJECT MATTER REJECTION OF CLAIMS 1-18 AND 25

On page 2 of the Office Action, claims 1-18 and 25 were rejected under 35 USC § 101 as being directed to non-statutory subject matter. This rejection is hereby respectfully traversed.

Regarding claims 1-9 and 11-17, the Examiner asserts that these "claims fail to set forth the operation of the claimed elements are tangible embodied on an article of manufacture." First of all, claims 1-9 and 11-17 do not recite anything regarding an article of manufacture. In contrast, claims 1-9 and 11-17 recite methods for outcomes monitoring (of surgical procedures). These methods recite steps that lead to the useful, concrete, and tangible result of "generating at least one outcomes monitoring report comprising the selected one of the at least one outcomes result and the norm."

Applicants again respectfully submit that there is no software program limitation on patentable subject matter as long

as the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601-02. As discussed above, claims 1-9 and 11-17 are all clearly directed to practical applications that produce a useful, concrete and tangible result.

Regarding claims 10, 18, and 25, in addition to the foregoing arguments, Applicants direct the Examiner to the case law set forth in In re Beauregard, 35 USPQ 2d 1383, 1384 (Fed. Cir. 1995), the recently decided In re Lundgren, (cite pending), and others, which clearly provide a patentable subject matter basis for these claims.

In view of the foregoing, it is respectfully requested that the aforementioned non-statutory subject matter rejection of claims 1-18 and 25 be withdrawn.

II. THE ANTICIPATION REJECTION OF CLAIMS 1-25

On pages 2-6 of the Office Action, claims 1-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Menzie et al. (U.S. Patent No. 6,650,932). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re

Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id.. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." Id..

The Examiner asserts that Menzie et al. discloses the claimed invention. However, Menzie et al. issued November 18, 2003, from U.S. Patent Application No. 09/750,683, filed May 15, 2000. Thus, Menzie et al. has an effective filing date of May 15, 2000.

Applicants again respectfully submit that the invention disclosed and claimed in the present application was conceived prior to May 15, 2000. Applicants also respectfully submit that they were duly diligent in preparing and filing the present application from the date of conception of the invention

disclosed and claimed in the present application to the filing date of the present application (i.e., November 20, 2001). Applicants support the above-stated submissions with supplemental inventor declarations under 37 C.F.R. § 1.131, which are submitted herewith, and which contain a showing of facts that clearly establish the above-stated submissions. Accordingly, Menzie et al. is not a proper prior art reference for application against the claims of the present application.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-25 be withdrawn.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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